

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:
Cary L. Bates et al.

Serial No.: 09/887.621

Confirmation No.: 7429

Filed: June 22, 2001

For: ENCOURAGING HOUSE CARD
USE THROUGH PRICE
GUARANTEES

Group Art Unit: 3622

Examiner: Michael Bekerman

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
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Date

/Joseph Jong/
Joseph Jong

Dear Sir:

APPEAL BRIEF

Applicants submit this Appeal Brief to the Board of Patent Appeals and Interferences on appeal from the decision of the Examiner of Group Art Unit 3622 dated October 18, 2006, finally rejecting claims 1-18 and 20-22, 24-30. The final rejection of claims 1-18 and 20-22, 24-30 is appealed. This Appeal Brief is believed to be timely since it is transmitted by the extended due date of June 20, 2007, as set by the filing of a Notice of Appeal on February 20, 2007. Please charge the fee of \$500.00 for filing this brief to Deposit Account No. 09-0465/ROC920010071US1.

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Real Party in Interest

The present application has been assigned to International Business Machines Corporation, Armonk, New York.

Related Appeals and Interferences

Applicant asserts that no other appeals or interferences are known to the Applicant, the Applicant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

Status of Claims

Claims 1-18, 20-22 and 24-30 are pending in the application. Claims 1-30 were originally presented in the application. Claims 19 and 23 have been canceled without prejudice. Claims 1-18, 20-22 and 24-30 stands finally rejected as discussed below. The final rejections of claims 1-18, 20-22 and 24-30 are appealed. The pending claims are shown in the attached Claims Appendix.

Status of Amendments

All claim amendments have been entered by the Examiner, including amendments to the claims proposed after the final rejection.

Summary of Claimed Subject Matter

A. Claim 1 - Independent

One embodiment of the invention provides a method for price-guaranteeing an item purchased by a customer. (¶[0007], Page 3, lines 16-17). The method starts by determining whether the item is purchased using a store credit card account for the store from which the item is purchased. (¶[0040], Page 12, lines 17-19; Figure 7, step 730). If the item is purchased using the store credit card account, receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price. (¶[0040], Page 12, lines 22-25, Figure 7, steps 735 and 740). The item purchase price is compared to a comparison price comprising at least one of an item current price and an item match price. (¶[0043], Page 13, lines 23-27, Figure 8, step 835). If the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer. (¶[0046], Page 15, lines 17-26, Figure 10, steps 1040 and 1045). If the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used. (¶[0047], Pages 15, line 33 to page 16 line 1, and page 16 lines 4-7).

B. Claim 13 - Independent

One embodiment of the invention provides a computer readable storage medium, comprising a program which, when executed by a processor, performs operations for price-guaranteeing an item purchased by a customer. (¶[0008], page 3, lines 23-25). The operations comprise the method detailed above in independent claim 1.

C. Claim 22 – Independent

One embodiment of the invention provides an apparatus 100 for price-guaranteeing an item purchased by a customer. (¶[0025], page 6, lines 21-23; Figure 1). The apparatus comprises a central computer system 120 having a processor 122, a memory 124 and one or more storage devices 132 for storing data connected to the

processor. ([0027], page 7, lines 15-29; Figure 1). The processor is configured to perform the method detailed above in independent claim 1.

Grounds of Rejection to be Reviewed on Appeal

1. Rejection of claims 1-11 and 13-28 under 35 U.S.C. § 103(a) as being unpatentable over *McClung* (U.S. Pub No. 2004/0143502).
2. Rejection of claims 11, 12, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over *McClung* in view of *Walker* (US Pub No. 2001/0042785).
3. Objection of claim 7 under 35 U.S.C. § 132(a) because the amendment filed on August 3, 2006 introduces new subject matter into the disclosure.

ARGUMENTS

- 1. Rejection of claims 1-11 and 13-28 under 35 U.S.C. § 103(a) as being unpatentable over *McClung* (U.S. Pub No. 2004/0143502).**

The Applicable Law/Standard

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143. The present rejection fails to establish at least the third criteria.

The Reference

McClung is directed to a computer-implemented method for guaranteeing a consumer a best price on an item or service purchased from a vendor for a predetermined time period following the transaction. (Abstract, *McClung*). The method disclosed by *McClung* monitors prices after a purchase by a consumer and if a lower price is found at a later time, gives a consumer a refund, a credit, and/or a coupon or certificate for use equaling the difference in sale prices. (See, e.g., ¶[0007], ¶[0150], Figures 5 and 11, *McClung*).

The Examiner's Argument

Regarding claims 1-7, 11, 13-18, the Examiner argues that

"McClung teaches a host computer system as tracking a transaction by the item and purchase price, receiving and storing price matching data including an item match price, comparing the purchase price to a comparison price (item match price) periodically (over different time periods), and administering a credit for the price differential to the customer if the comparison price is lower than the purchase price (Paragraph 0007). The system would inherently have to obtain an account

number (customer identification number) in order to credit the customer's account. McClung also teaches the credit card account as being an account with the vendor (Paragraph 0008, Sentence 3 and Paragraph 0131, Sentence 1). A step of determining whether a user is a member of the system (signed up through a vendor) is inherent when a purchase takes place. McClung, however, does not specify what action takes place should a user not have an account with the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up."

Applicants' Response to the Examiner's Argument

Applicants respectfully submit that *McClung* does not teach or suggest all the claim limitations. For example, *McClung* does not teach or suggest determining whether the item is purchased using a store credit card account for the store from which the item is purchased. The Examiner argues that "[a] step of determining whether a user is a member of the system (signed up through a vendor) is inherent when a purchase takes place." Applicants respectfully submit that such determining step is not at all inherent when a purchase takes place. For example, a customer who has a store credit card or account (i.e., a "member of the system") may make a purchase using another credit card or cash without ever disclosing that he has a store credit card. The purchase would take place without determining whether the customer is a "member of the system."

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As such, the step of determining whether a user is a member of the system is not inherent and is not taught or suggested by *McClung*. Moreover, as recited in the claims, the determination is with respect to an item purchased as related to a store credit card

account, not with respect to whether the purchaser is a “member of the system.” No such determination is taught or suggested by *McClung*.

As another example, *McClung* does not teach or suggest that different actions are performed based upon the determination of whether the item is purchased using a store credit card account for the store from which the item is purchased. As recited in the claims, price guarantee credits are given only for items purchased using a store credit card account, whereas, for items not purchased using a store credit card account, a notification is given to the customer about the potential credits obtainable if the store credit card had been used.

As yet another example, *McClung* does not teach or suggest notifying the customer of potential credits obtainable if the store credit card had been used, if the item is not purchased using the store credit card account. The Examiner argues that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up.” Applicants respectfully submit that the Examiner has mischaracterized the teachings of the cited reference and has applied improper hindsight in stating that such feature would have been obvious. *McClung* does not teach or suggest any different treatment between customers who used store credit cards to make a purchase and those who did not, since *McClung* discloses providing price guarantees to customer without distinguishing treatments between customers who have store credit cards and those who do not. Therefore, there is no teaching or suggestion by *McClung* for notifying customers of the potential credits.

The other pending independent claims are rejected pursuant to the same rationale as was claim 1 (Examiner's Final Action, p. 6, paragraph 10) and, accordingly, are believed to be allowable for the same reasons given above. Since Applicants believe that the independent claims are allowable, the dependents are therefore also believed to be allowable.

2. Rejection of claims 11, 12, 29 and 30 under 35 U.S.C. § 103(a) as being unpatentable over *McClung* in view of *Walker* (US Pub No. 2001/0042785)

The References

McClung is discussed above. *Walker* discloses a financial tender system which allows a transferor to transfer credit or make payment to a transferee by debiting the credit card of the transferor and crediting the credit card of the transferee. (Abstract, *Walker*).

The Examiner's Argument

Regarding claims 11, 12, 29 and 30, the Examiner argues that

"*McClung* teaches crediting an account with a vendor to implement a guaranteed pricing promotion. *McClung* doesn't teach the transferring of balances between different credit accounts. *Walker* teaches that it is well-known to transfer debt balances between accounts to take advantage of different account features (Paragraph 0011, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a credit balance from one account to another in order to take advantage of retailer guaranteed pricing. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to potential credits that could be incurred through transferring a balance. This would provide a greater chance of that non-member transferring the balance."

Applicants' Response to the Examiner's Argument

Applicants respectfully submit that *McClung*, as discussed in the above examples, fails to teach or suggest all of the claim limitations with respect to the independent claims. Moreover, the cited references, *McClung* and *Walker*, either alone or in combination, fail to teach or suggest notifying the customer of potential credits if the item is not purchased using the store credit card account. Furthermore, the cited references, either alone or in combination, fail to teach or suggest determining whether the customer has transferred a balance from another credit card account to the store credit card account, wherein the amount is credited to the store credit card account of the customer if the customer has transferred a balance from another credit card account

to the store credit card account. Applicants respectfully submit that the Examiner again has applied improper hindsight in stating that such feature would be obvious. The cited references simply do not provide any teaching or suggestion for any incentive for transferring balances.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

3. Objection of claim 7 under 35 U.S.C. § 132(a)

The Examiner states that added material in claim 7 is not supported by the original disclosure. Applicants respectfully submit that the specification clearly supports that different types of explanation are stored in the customer credit records (Specification, Paragraph [0037], last four sentences) and that the customer may be notified of a low price guarantee credit (See, e.g., Paragraph [0034], last sentence). The explanations stored in relation to each price guarantee credit are natural extensions of the contents of the notifications to the customer.

Therefore, the objection is believed to be improper, and withdrawal of the objection is respectfully requested.

CONCLUSION

The Examiner errs in finding that:

1. Claims 1-11 and 13-28 are unpatentable over *McClung*;
2. Claims 11, 12, 29, and 30 are unpatentable over of *McClung* in view of *Walker*; and
3. The amendment filed on August 3, 2006 introduced new matter.

Withdrawal of the rejections and objection and allowance of all claims is respectfully requested.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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CLAIMS APPENDIX

1. (Previously Presented) A method for price-guaranteeing an item purchased by a customer, comprising:
 - determining whether the item is purchased using a store credit card account for the store from which the item is purchased;
 - if the item is purchased using the store credit card account:
 - receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;
 - comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and
 - if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer; and
 - if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used.
2. (Previously Presented) The method of claim 1, wherein the store credit card account is a department store credit card account.
3. (Original) The method of claim 1, wherein the amount represents a price differential between the item purchase price and the comparison price.
4. (Original) The method of claim 1, wherein the transaction data includes one or more information selected from a customer identification number, an item description, a quantity of item purchased and a purchased date.
5. (Original) The method of claim 1, wherein the step of comparing is periodically performed.
6. (Original) The method of claim 1, further comprising:

receiving, by the central computer system, price matching data from the cash register computer system, the price matching data including at least one of an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

storing price matching data into a data storage device of the central computer system.

7. (Previously Presented) The method of claim 1, further comprising:
providing an explanation to the customer for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and
an error.

8. (Original) The method of claim 1, wherein the transaction data further includes an item purchase date.

9. (Previously Presented) The method of claim 8, further comprising:
comparing the item purchase date to a current date;
if the item purchase date is the same as the current date, comparing the item purchase price to the item current price to determine whether an error occurred; and
if the error occurred, crediting a price differential to the credit card account of the customer.

10. (Original) The method of claim 8, further comprising:
comparing the item purchase date to a current date; and
crediting the amount only if the current date is within a price-guarantee period from the item purchase date.

11. (Previously Presented) The method of claim 1, further comprising:

if the item is not purchased using the store credit card account, notifying the customer of potential credits if a balance is transferred from another credit card account to the store credit card.

12. (Previously Presented) The method of claim 11, further comprising:

determining whether the customer has transferred a balance from another credit card account to the store credit card account, wherein the amount is credited to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

13. (Previously Presented) A computer readable storage medium, comprising a program which, when executed by a processor, performs operations for price-guaranteeing an item purchased by a customer, the operations comprising:

determining whether the item is purchased using a store credit card account for the store from which the item is purchased;

if the item is purchased using the store credit card account:

receiving, by a central computer system, transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;

comparing the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and

if the item purchase price is higher than the comparison price, crediting an amount to the store credit card account of the customer; and

if the item is not purchased using the store credit card account, notifying the customer of potential credits obtainable if the store credit card had been used.

14. (Previously Presented) The computer readable storage medium of claim 13, wherein the amount represents a price differential between the item purchase price and the comparison price.

15. (Previously Presented) The computer readable storage medium of claim 13, wherein the transaction data includes one or more information selected from a customer identification number, an item description, a quantity of item purchased and a purchased date.

16. (Previously Presented) The computer readable medium of claim 13, wherein the step of comparing is periodically performed.

17. (Previously Presented) The computer readable storage medium of claim 13, wherein the operations further comprise providing an explanation to the customer for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and
an error.

18. (Previously Presented) The computer readable storage medium of claim 13, wherein the operations further comprise:

receiving, by the central computer system, price matching data from the cash register computer system, the price matching data including at least one of an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

storing price matching data into a data storage device of the central computer system.

19. (Canceled)

20. (Previously Presented) The computer readable storage medium of claim 13, wherein the transaction data further includes an item purchase date, and wherein the operations further comprise:

comparing the item purchase date to a current date;

if the item purchase date is the same as the current date, comparing the item purchase price to the item current price to determine whether an error occurred; and

if an error occurred, crediting a price differential to the credit card account of the customer.

21. (Previously Presented) The computer readable storage medium of claim 13, wherein the transaction data further includes an item purchase date, and wherein the operations further comprise:

comparing the item purchase date to a current date; and

crediting the amount only if the current date is within a price-guarantee period from the item purchase date.

22. (Previously Presented) An apparatus for price-guaranteeing an item purchased by a customer, comprising:

a central computer system having a processor, a memory and one or more storage devices for storing data connected to the processor, wherein the processor is configured to:

determine whether the item is purchased using a store credit card account for the store from which the item is purchased;

if the item is purchased using the store credit card account:

receive transaction data from a cash register computer system, the transaction data including an item identification number and an item purchase price;

compare the item purchase price to a comparison price comprising at least one of an item current price and an item match price; and

if the item purchase price is higher than the comparison price, credit an amount to a store credit card account of the customer; and

if the item is not purchased using the store credit card account, notify the customer of potential credits obtainable if the store credit card had been used.

23. (Canceled)

24. (Original) The apparatus of claim 22, wherein the processor is further configured to periodically compare the item purchase price to the comparison price.

25. (Original) The apparatus of claim 22, wherein the processor is further configured to:

receive price matching data from the cash register computer system, the price matching data including one or more information selected from an item identification number, the item match price, an item sale start date, an item sale duration, and a competitor store identification; and

store price matching data into a data storage device of the central computer system.

26. (Previously Presented) The apparatus of claim 22, wherein the processor is further configured to provide an explanation to the customer for crediting the credit card account of the customer, wherein the explanation is selected from one of:

a price guarantee credit for a price reduction from the same department store;

a price match credit for matching a price from another store; and
an error.

27. (Previously Presented) The apparatus of claim 22, wherein the processor is further configured to

receive transaction data including an item purchase date;

compare the item purchase date to a current date;

if the item purchase date is the same as the current date, compare the item purchase price to the item current price to determine whether an error occurred; and

if an error occurred, credit a price differential to the credit card account of the customer.

28. (Original) The apparatus of claim 22, wherein the processor is further configured to:

receive transaction data including an item purchase date;

compare the item purchase date to a current date; and

credit the amount only if the current date is within a price-guarantee period from the item purchase date.

29. (Previously Presented) The apparatus of claim 22, wherein the processor is further configured to:

if the item is not purchased using the store credit card account, notify the customer of potential credits if a balance is transferred from another credit card account to the store credit card account;

determine whether the customer has transferred a balance from another credit card account to the store credit card account; and

credit the amount to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

30. (Previously Presented) The computer readable medium of claim 13, wherein the operations further comprise:

if the item is not purchased using the store credit card account, notify the customer of potential credits if a balance is transferred from another credit card account to the store credit card account;

determine whether the customer has transferred a balance from another credit card account to the store credit card account; and

credit the amount to the store credit card account of the customer if the customer has transferred a balance from another credit card account to the store credit card account.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.